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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,909	04/13/2004	Andrew J. Nelson	1878.001US1	3568
21186	7590	05/01/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.			SCHWARTZ, JORDAN MARC	
P.O. BOX 2938			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55402			2873	

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/822,909

Applicant(s)

NELSON ET AL.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10, 29, 33, 34, 49-51, 54 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 29, 33, 34, 49-51, 54 and 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restriction***

For applicant's information, the claims as amended are all now directed to a species of method of displaying information or a species of athletic eyewear capable of displaying information in which a display comprises a plurality of light pipes. Therefore, all of the pending claims, including claims 50 and 54 previously grouped within non-elected groups and newly presented claim 57 have all been considered herein.

For applicant's further information, claim 49, previously indicated as a generic claim, is no longer generic based upon the amendment to the claims. Regardless, the non-elected groups have been cancelled.

### ***Claim Rejections - 35 USC § 112***

Claims 1, 4, 29, 33, and 49 (and dependent claims 2-3, 5-7, 10, 34, 50-51, 54, and 57) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1, 29, 33, and 49, in claim 1, claiming "a plurality of light pipes in the lens in order to form a segment display", in claim 29 claiming a "plurality of light pipes are configured to form a segment display", in claim 33, claiming "the display is formed from a plurality of light pipes" and in claim 49, claiming "forming a segment display from a plurality of light pipes" renders the claims vague and indefinite.

Specifically, in the specification and Figures, applicant discloses the display comprising light up segments (such as Figure 5, "20") with each light up segment connected to

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separate "light pipes" (such as Figure 5, "28"). Apparently, from what is disclosed in the Figures and specification, the display is formed by both the light up segments and the light pipes. Therefore, in claim 1, by claiming the light pipes "in order to form a segment display" (and the similar language used in claims 29, 33, and 49) it is not clear if by "light pipes" applicant is referring to the light pipes "28" or if applicant is referring to the light up segments "20" (which would be inconsistent with the use of the term "light pipes" within the specification) and the lack of clarity renders the claims vague and indefinite. For purposes of examination, in claim 1, the assumed meaning is "embedding a plurality of light up segments and a plurality of light pipes in the lens in order to form a segment display" (with similar meaning to claims 29, 33 and 49) and further clarity is required.

In reference to claims 4 and 49, claiming "directing light into a light pipe associated with each segment to be lit" renders the claims vague and indefinite. It is not clear if applicant is claiming that a single light pipe can be associated with numerous segments i.e. a single light pipe can be associated with each segment or if applicant is claiming "directing light into a plurality of light pipes with each light pipe associated with a separate segment to be lit" (with the latter being the assumed meaning) and further clarity is required.

### ***Claim Objections***

Claims 1, 4, 29, and 49 (and their respective dependent claims) are objected to for the following reasons. Since the intended meaning could be determined from the

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specification and the Figures, 112 rejections were not made but instead these lack of clarity issues are being raised in the following claim objections.

With respect to claims 1, 4, 29 and 49, claiming a "segment display" creates a lack of clarity because any display will inherently comprise components which could each be considered as "segments" creating a lack of clarity. For example, any numerical display could inherently be considered a "segment display" because each of the numerals could be considered as separate segments. For purposes of examination and based upon what is disclosed in the specification and Figures, the assumed meaning is a plurality of light up segments and a plurality of light pipes in the lens in order to form a segment display".

With respect to claims 4 and 49 claiming "with each segment to be lit" creates a lack of clarity because applicant has previously only claimed a "segment display" but has not claimed that the segments are lit. If lighting the segments are intended (as is herein assumed from what is set forth in the specification and Figures) then it is suggest that applicant claim in claim 4 "the display is a segment display comprising a plurality of light up segments and a plurality of light pipes and wherein when activated..." (with similar changes to claims 49).

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claim 3 now depends from claim 4, however the limitations of claim 3 are already set forth in claim 4

as amended and therefore claim 3 is not further limiting. Furthermore, suspending the light pipes in the resin will inherently be "embedding" them.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 94/09398 (herein referred to as "WO'398").

WO'398 reads on these claims by disclosing the limitations therein including the following: a method of displaying information on eyewear (abstract, Figure 1); the information as "performance information" (page 4, line 17 to page 5, line 19 such as "a stop watch to show elapsed time"); comprising forming a lens wherein forming includes embedding light pipes in the lens (abstract, page 8, lines 3-11 re embedded "fiber optic means" in the lens which would inherently be light pipes); the lens having light up segments embedded in the lens (Figure 1 with the light up numerals each as "segments"); the display as a "segment display" (Figure 1, each of the numerals can be considered as "segments" and therefore as a "segment display") mounting the lens in the eyewear (Figure 1); activating the display from a source outside the lens (Figure 1, page 4, lines 25-31 re button batteries or solar panels on the frame); the lens mounted in the display such that it is viewable by a user wearing the eyewear (Figure 1); the display controller driving the display as a function of the information to be displayed

(page 4, line 17 to page 5, line 19, page 7, lines 5-35); the display receiving information from a measuring device and driving the display as a function of this information (page 4, line 32 to page 5, line 3 the display as a watch or stopwatch and therefore either measuring time or measuring elapsed time). The eyewear of WO'398 could inherently be considered as "athletic" eyewear since it is being disclosed as providing on the display a stop watch for elapsed time (page 4, line 17 to page 5, line 19). Regardless, the claimed "athletic eyewear" goes to the intended use of the eyewear. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO'398 in view of Gotah et al patent number 6,705,725.

WO'398 discloses as is set forth above including embedding the display within the optical material of the lens and that the embedded display can include light pipes (page 8, lines 3-11). The light pipes would inherently have to be suspended in the optical material prior to hardening in order for the light pipes to be located within the

optical material of the lens. WO'398 discloses as is set forth above but does not specifically disclose the optical material of the lens as a resin formed by molding. Gotah teaches that eyeglass lenses can be formed by molding resin material for the purpose of providing an eyeglass lens of improved surface accuracy and optical properties (column 1, lines 13-25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the eyeglass lens of WO'398 as formed by molding a resin material since Gotah teaches that eyeglass lenses can be formed by molding resin material for the purpose of providing an eyeglass lens of improved surface accuracy and optical properties.

#### ***Examiner's Comments***

For applicant's information, this action has not been made final due to the 112 rejections of claims 4 and 33 set forth above that were not previously raised in the prior office action.

For applicant's further information, with respect to claim 49, Linden patent number 5,585,871 would have made obvious this claim if the examiner had not made the assumed meaning as set forth above of "each light pipe associated with a separate segment to be lit".

As a suggestion, in claim 1, claiming "embedding a plurality of light up segments and a plurality of light pipes in the lens in order to form a segment display with each light pipe associated with a separate segment to be lit" (with similar changes to claims 4, 29 and 49) would overcome the 112 rejections and objections to the claims set forth above and would also read over the art of record.



As a suggestion, in claim 33, claiming “wherein the display is formed from a plurality of light up segments and a plurality of light pipes” would overcome the 112 rejection above and would place the claim in condition for allowance.

***Allowable Subject Matter***

Claims 4, 33, and 49 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 3, 5-7, 34, 50-51, 54, and 57 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claims 3-7, 49-50, 51, 54, none of the prior art either alone or in combination, disclose or teach of the claimed method of displaying performance information on athletic eyewear specifically including, as the distinguishing features in combination with the other limitations, the claimed display as a segment display comprising a plurality of light up segments and a plurality of light pipes and wherein activating includes directing light into a plurality of light pipes with each light pipe associated with a separate segment to be lit. Specifically, with reference to claims 33-34 and 57, none of the prior art either alone or in combination, disclose or teach of the claimed athletic eyewear specifically including, as the distinguishing features in combination with the other limitations, the claimed display

formed from a plurality of light up segments and a plurality of light pipes wherein an end of each light pipe is attached to a shutter.

### ***Response to Arguments***

Applicant's arguments filed February 27, 2006 have been considered but, with respect to the claims rejected above, they are not persuasive. Applicant argues that WO'398 does not disclose embedding a plurality of light pipes in the lens in order to form a segment display. The examiner disagrees as set forth in the rejection above. Specifically, WO'398 discloses embedding fiber optics into the lens for the display and the examiner believes that fiber optic pipes would be the same as light pipes. With respect to claim 2, applicant argues that Gotah does not teach of the lens being formed by resin molding. The examiner disagrees as set forth above. WO'398 discloses suspending i.e. embedding light pipes in the lens and Gotah teaches of using resinous materials.

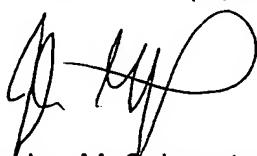
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:30 to 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached at (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J. Schwartz', with a large, stylized loop at the end.

Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
April 19, 2006